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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,208	05/08/2001	Keiichi Nakajima	P-277852/NI-	6261

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EXAMINER

GREENE, DANIEL L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/786,208

Applicant(s)

NAKAJIMA, KEIICHI

Examiner

Daniel L. Greene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 January 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11,40,41,46,47, and 52-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11,40,41,46,47 and 52-77 is/are rejected.
- 7) ☒ Claim(s) 97-100 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 1/31/2006 have been fully considered but they are not persuasive.

Claims 1-11, 40, 41, 46, 47, 52-77 and 97-100 are pending.

Claims 1, 3, 52-54, 62-66, 69, 72, 74-77 are amended and claims 97-100 are added.

The Applicant argues that the August 16, 2005 response provided numerous examples of the failure of Takayama and Stein et al., alone and in combination, to disclose or suggest features recited in claim 1. The Examiner submits that a reference is to be considered not only for what it expressly states, but also for what it would reasonably have suggested to one of ordinary skill in the art. *In re DeLisle*, 160 USPQ 806 (CCPA 1969). In addition, the Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Evaluation of the arguments on page 19, line 24 through page 20, line 11, of the August 16, 2005 response, the issue of the limitation that the first and second terminals

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are located at the same site is now a non-issue because the Applicant has removed it from the claims. However, Takayama discloses Col. 3, lines 60-62 and Col. 4, line 3, the distance between the two units is at most 1 to 2 meters and the use of infrared ray radiation that requires the two units to be at the same site.

The Applicant's second argument was no disclosure or suggestion by either Takayama or Stein et al. of transferring the Transaction ID information from the first terminal to the second terminal. Page 20, lines 3-4. The Examiner submits that Takayama discloses the system and method for the first terminal (operator of the cash register **101**, Col. 47, lines 20-25, merchant) does communicate via the infrared system with the second terminal (user **100**) and provides data to the user specific to the transaction being conducted. The Applicant argues that the data supplied to the user does not contain the transaction ID and neither of the cited references provides for the Transaction ID being provided to the user via the infrared transmitter.

Specific and detailed review shows that the Applicant is correct however; the analysis also disclosed that the Allowable Subject Matter that the Examiner submitted that was unique, original and non-obvious is found to be in error. As taught by Takayama the user terminal does in fact have two types of communications and is in fact able to communicate both ways with the merchant (Infrared) and the settlement server (antenna). Therefore the amendment of the pending claims to include the previous described features to render the claims allowable is withdrawn.

In reference to the data being sent between the merchants, the user and the transaction server, the Applicant submits that the combination of the user ID and the

transaction ID being used together is unique, non-obvious and original. The Examiner disagrees and submits a new reference, Stambler, US 5,267,314, as teaching that tying the user ID and the transaction ID together in communications relating to a transaction is old and well known in the art.

The Applicant on page 13, last sentence states "... errors in the examiner's reliance on the doctrine of Official Notice ..." The Examiner submits that the reference to Official Notice is in reference to claims 5-7 that were rejected in the last action under Takayama and not Official Notice rendering the argument moot.

In reference to the Applicant's argument that the location of the two terminals is claimed subject matter and not "descriptive material" the Examiner disagrees. As stated in the rejection, the transfer of information during the transaction would occur regardless of where the two terminals were located. The location of the two sites within the ranges of their transmitters/receivers, does not modify, affect and/or render the application unique, original or non-obvious because the transfer of information during the transaction would occur regardless of where the two terminals were located. A reference is to be considered not only for what it expressly states, but also for what it would reasonably have suggested to one of ordinary skill in the art. *In re DeLisle*, 160 USPQ 806 (CCPA 1969) *Takayama* teaches the use of two terminals separated from each other. This renders the specific location of the two terminals obvious and well known in the art.

In reference to claims 1, 3, 62, 66, 72 and 77, the Allowable Subject Matter that the Examiner submitted that was unique, original and non-obvious is found to be in

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error. As taught by Takayama the user terminal does in fact have two types of communications and is in fact able to communicate both ways with the merchant (Infrared) and the settlement server (antenna). Therefore the amendment of the pending claims to include the previous described features to render the claims allowable is withdrawn.

***Allowable Subject Matter***

Claims 97-100 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. **Claims 1-11, 40-41, 46-47, and 52-77** are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,332,133 *Takayama* in view of US 5,826,241 to Stein et al. (Stein) and US 5,267,314 Stambler.

**As per Claims 1, 3, 40-41, 46-47, 52, 62, 66, 72, and 77:**

*Takayama* discloses the invention substantially as claimed including in a settlement apparatus performing a settlement of a transaction, which communicates with a billing terminal performing billing of the transaction and with a paying terminal performing paying of the transaction, the apparatus comprising:

a first terminal (Fig. 3, 300) connecting to the communication network (Fig. 3, 110) and having an information indicating unit (Fig. 3, 314), the information indicating unit having an infrared transmitting unit (Fig. 3, 301);

a second terminal having a unique ID information, and antenna (For example Fig. 2A, 201) and input unit, the input unit having an infrared receiving unit (For example Fig. 2A 202) said second terminal being connectable to said first terminal through the communication network with said antenna; For example Fig. 1, 106, 104, 108).

a transaction apparatus communicating with said first and second terminals through the communication network (For example Fig. 1, ele. 102, 103), said transaction apparatus storing said unique ID information of said second terminal in advance (For example Col. 45, lines 16-22), said transaction apparatus setting up and sending a transaction ID information to said first terminal, said transaction apparatus receiving from said second terminal said unique ID information of said second terminal

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together with said transaction ID information transmitting from said infrared transmitting unit of said first terminal to said infrared receiving unit of said second terminal, said transaction apparatus performing the transaction by synchronizing a communication with said first terminal and said second terminal when said unique ID information received from said second terminal is identical with that stored in said transaction apparatus in advance previously. (For example Col. 71, lines 32-40).

Takayama does not specifically disclose that the transmission of the transaction identification number by the paying terminal is an element of synchronization. Stein discloses this limitation at for example Col. 7, line 33 to Col. 9, line 45, particularly Col. 8, lines 1-18. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Takayama with the transmission of a transaction identifier number because this would provide a uniquely generated identifier to facilitate confirmation that a transaction was valid. See Stein at for example Col. 7, lines 58-60 and Col. 8, line 37 to Col. 9, line 23 for support of this motivation. Note also that both references are directed to settlement of financial transactions; see Takayama at for example Title and Abstract, at least, and Stein at for example Col. 3, line 38 to Col. 4, line 8.

Further, Takayama and Stein discloses the claimed invention except for the transmitting of the transaction ID from the first terminal to the second terminal and the transaction apparatus receiving from the second terminal its unique ID information together with the transaction ID information. Stambler teaches that it is known in the art to provide a joint code associated with one or more of the parties involved in a



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transaction. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide in the data sent from the first terminal to the second terminal a transaction ID of Takayama with the joint coding of Stambler (For example Col. 2, lines 1-20), in order to validate that the different data items are connected and related. As taught by Stambler, it is old and well known to provide transaction data (ID) with other relevant data (price, user ID, etc) to insure that different data items are associated with each other.

**Concerning Claims 2 and 4,** *Takayama* discloses that the first terminal communicates over a telephone line at Fig. 1, ele. 110,109. *Takayama* further discloses that the paying terminal connects to the settlement apparatus by radiotelephone communications at Col 43, line 59 to col. 44, lines 29.

**Concerning Claim 5;**

Takayama further discloses:

said first communication unit receives a purchase amount of the transaction from the first terminal at Col. 47, lines 20-25.

said second communication unit transmits said purchase amount to the second terminal so that the second terminal confirms said purchase amount, and receives a finale purchase confirmation signal. For example Fig. 3, 301, Col. 47, lines 25-45.

*Takayama* discloses receipt of a purchase amount from a billing terminal for settlement at for example Col. 4, line 11 to col. 5, line 17. *Takayama* further discloses a

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settlement completion notification at for example Col. 11, lines 49-60 and a receipt to the paying terminal of a settled amount at for example Col. 52, lines 6-10.

**Concerning Claims 6-7**, Takayama further discloses unique identification of financial terminals and confirmation through such identification. For example Fig. 32 A-D.

**Concerning Claims 8-10**, *Takayama* discloses a purchase history at Col. 71, lines 26-58.

As per **Claim 11**:

Takayama further discloses:

that a billing unit (Fig. 4, ele. 403) in receipt of a transaction identifier (Fig. 2, Order Number) sends the transaction identifier (Fig. 7H) to a paying unit (Fig. 4, ele 400) which then forwards the transaction identifier to a processing unit (Fig. 404).

As per claim 53:

Takayama further discloses:

wherein said information-indicating unit of said first terminal further comprises a display or a speaker. For example Fig. 2A, 202.

As per claim 54:

Takayama further discloses:

wherein said first terminal is a terminal for a plurality of unspecified users and said second terminal is a unique terminal for the user. Fig. 3, Fig. 2A

As per claims 55 and 56:

Takayama further discloses:

wherein the second terminal is a portable/ terminal/phone. Fig. 2A.

As per claims 57-61:

Takayama further discloses:

transaction apparatus that provides communications between the different entities of the transaction. Fig. 4.

As per claims 63, 67 and 73:

Takayama further discloses:

further comprising steps of inputting said unique ID information thereof from said input unit of said second terminal into transaction apparatus, and wherein said storing said unique ID information includes storing said transaction ID information in association with said unique ID information in advance. For example Col. 4, line 11 to Col. 5, lines 17, Col. 11, lines 49-60.

As per claims 64, 69 and 74:

Takayama further discloses:

wherein the transaction system includes a plurality of first terminals and second terminals; and wherein said setting up the transaction ID information includes setting up a plurality of transaction ID information different from each other, based on each instant of the current time, in accordance with each instructions from each of said terminals.

For example Col. 77, lines 1-67.

As per claims 65, 70 and 75:

Takayama further discloses:

comprising a step of permitting said first terminal to perform a function and permitting said second terminal to perform another function, during the synchronization:

For example[le Col. 93, lines 30-67.

As per claims 68, 71 and 76:

Takayama further discloses:

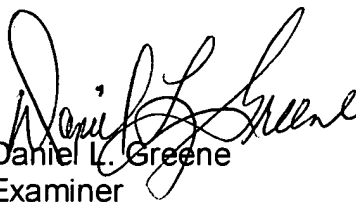
wherein said processing unit synchronizes the communication with said first terminal and second terminal one-to-one. Col. 72, lines 25-46.

***Conclusion***

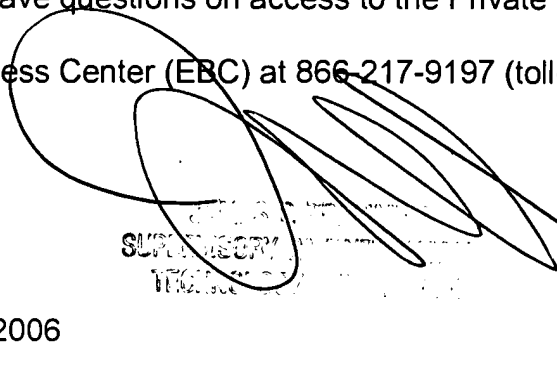
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 571-272-6707. The examiner can normally be reached on M-Thur. 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel L. Greene  
Examiner  
Art Unit 3621



3/16/2006